

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LES LONG



Appeal No. 2005-1861
Application No. 09/634,402

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 36 to 56, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a system and method for more efficiently replacing a set of folding boards with another set of folding boards (specification, pp. 2-3). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Murphy et al. (Murphy)	3,472,504	Oct. 14, 1969
Montguire	3,513,743	May 26, 1970

Claims 36 to 56 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murphy in view of Montguire.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (mailed April 23, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed February 26, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 36 to 56 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the applied prior art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000), In re Gartside, 203 F.3d 1305, 1319, 53

USPQ2d 1769, 1778 (Fed. Cir. 2000), Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). As stated by the Federal Circuit in Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1276, 69 USPQ2d 1686, 1690 (Fed. Cir. 2004)

this court has consistently stated that a court or examiner may find a motivation to combine prior art references in the nature of the problem to be solved. See *Pro-Mold*, 75 F.3d at 1573; *Display Techs., Inc. v. Paul Flum Ideas, Inc.*, 282 F.3d 1340, 1346-47 (Fed. Cir. 2002); *In re Huang*, 100 F.3d 135, 139 n.5 [40 USPQ2d 1685] (Fed. Cir. 1996). This form of motivation to combine evidence is particularly relevant with simpler mechanical technologies.

In the obviousness rejection under appeal, the examiner (answer, p. 3) determined that (1) Murphy discloses a set of folding boards; (2) Murphy does not disclose a rotatable frame with two or more sets of folding blades for replacing one set with a second set; (3) Montguire teaches the use of frame assemblies mounted for rotation about an axis to allow an operator to perform maintenance or tool changing on one frame assembly while the other frame assembly is being used, thereby reducing down time; and (4) it would have been obvious to one having ordinary skill in the art at time of invention to have provided Murphy's folding apparatus with a second set of folding assembly (frame assembly, second bar and folding boards) where the first and second frame assemblies are mounted so as to rotate about an axis as taught by

Montguire to facilitate tool maintenance or tool changing of one assembly while the other frame assembly is being used to thereby reduce apparatus down time.

The appellant argues that the applied prior art does not suggest the claimed subject matter. We agree. We have reviewed the teachings of Murphy and Montguire but fail to find therein any evidence of a suggestion, teaching, or motivation for one skilled in the art to have modified Murphy so as to arrive at the claimed subject matter. In our view, the only suggestion for modifying Murphy in the manner proposed by the examiner stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 36 to 56 under 35 U.S.C. § 103 is reversed.

REMAND

We remand this application to the examiner for further consideration of the patentability of claims 36 to 56 under 35 U.S.C. § 103 as set forth below.

The examiner should determine if the appellant's statements on page 2, lines 18-25, of the specification constitute an admission of prior art that it was known in the art that the folding boards must be manually interchanged by removing each individual folding board from the line so as to be able to utilize a set of folders having a different size or configuration and that such manual interchanging of folding boards can require a substantial amount of time and energy and that such manual interchanging often results in the misalignment of the folding boards.

If the appellant's statements on page 2, lines 18-25, of the specification constitute an admission of prior art, then the examiner should determine the patentability of claims 36 to 56 under 35 U.S.C. § 103 over the combined teachings of that admitted prior art and Montguire.^{1,2}

¹ Montguire is analogous art since it is reasonably pertinent to the problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). In the present instance, we are informed by the appellant's originally filed specification that the invention is particularly directed to replacing the manual interchanging of folding boards with a more efficient system. Montguire teaches replacing the manual interchanging of slitter heads with a more efficient system and thus logically would have commended itself to an artisan's attention in considering the appellant's problem. Thus, we conclude that Montguire is analogous art.

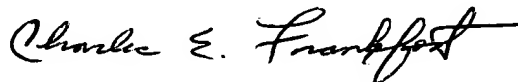
² The appellant's statements on page 2, lines 18-25, of the specification if an admission of prior art would appear to provide the motivation (lacking in Murphy as noted above) required under 35 U.S.C. § 103 for one skilled in the art to have modified Murphy based on the teachings of Montguire.

CONCLUSION

To summarize, the decision of the examiner to reject claims 36 to 56 under 35 U.S.C. § 103 is reversed. In addition, this application has been remanded to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REVERSED; REMANDED



CHARLES E. FRANKFORT
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)

Appeal No. 2005-1861
Application No. 09/634,402

Page 8

DORITY & MANNING, P.A.
POST OFFICE BOX 1449
GREENVILLE, SC 29602-1449

JVN/jg